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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/858,245 05/19/97 PADOVANI

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LM12/0421

EXAMINER

VD,N

ART UNIT

PAPER NUMBER

2745

DATE MAILED:

04/21/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/858,245

Applicant(s)

Padovani

Examiner

Nguyen Vo

Group Art Unit

2745



☒ Responsive to communication(s) filed on Feb 7, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 4-23 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 4-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

1. This action is in response to applicant's amendment filed on 02/07/00. Claims 4-23 are now pending in the present application. This action is made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4-9, 11-23 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

First of all, since independent claim 10 is amended to delete the recitations "**regardless of the strength of pilot**", claim 10 is no longer is rejected under 35 U.S.C. 112, first paragraph.

As to independent claims 4, 11, 16-17 and 22, the original specification fails to disclose the limitations "**regardless of the measurement value**" as recited in claims 4, 11, 17 and "**regardless of the strength of pilot**" as recited in claims 16, 22. Applicant's attention is directed to the original specification, page 9 line 29 to page 10 line 6, wherein pilot strength is measured and transmitted to the base station only if the pilot strength satisfies three conditions, *not regardless of the measurement*

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value as recited in the claims. Therefore, it is clear that **the measurement values are collected and saved only if they satisfy three conditions.**

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Andersson (5,375,123).

As to claim 10, Andersson discloses all the claimed limitations. More specifically, “a set of parameters” as claimed read on the set of transmission power to be used by a plurality of base stations (see column 4 lines 47-48); “operating the cellular network in a predetermined interval” as claimed reads on the time interval in which a mobile station measures pilot signals, and reports the measured pilot signals to the base stations (see column 4 lines 14-49); “collecting and saving data from received pilot strength measurement messages” as claimed reads on receiving the measurement values at the base stations (see column 4 lines 14-49); and “revising said set of parameters in accordance with said data from received pilot strength measurement messages” as claimed reads on modifying the transmission power at the base stations (see column 4 lines 42-49).

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6. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Blakeney, II (5,267,261; hereinafter simply referred to as Blakeney).

As to claim 10, Blakeney discloses all the claimed limitations. More specifically, “a set of parameters” as claimed read on the Active Set, Candidate Set and Neighbor Set at column 21 lines 48-68; “operating the cellular network in a predetermined interval” as claimed reads on the time interval in which a mobile station measures pilot signals, and reports the measured pilot signals in Blakeney; “collecting and saving data from received pilot strength measurement messages” as claimed reads on column 19 lines 13-22, column 20 lines 3-17, column 22 lines 46-56, column 23 line 19 to column 28; and “revising said set of parameters in accordance with said data from received pilot strength measurement messages” as claimed reads on modifying the above Active Set, Candidate Set and Neighbor Set as disclosed at column 19 lines 13-22, column 20 lines 3-17, column 22 lines 46-56, column 23 line 19 to column 28 in Blakeney.

Response to Arguments

7. Applicant's arguments with respect to claims 4-23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant, in his response, asserts that the rejection to claims under 35 U.S.C. 112, first paragraph, is improper. More particularly, applicant asserts that “In one embodiment, these pilot strength messages **may be** saved regardless of their strength” (see page 10 of applicant's response. Emphasis added by the examiner). The examiner, however, disagrees with applicant for two reasons.

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First, the examiner finds applicant's assertion unsupported. It is unclear where the above "one embodiment" is found in the original specification. If applicant still disagrees with the examiner, he is requested in the next response to clearly show which portions of the original specification that disclose and support the above "one embodiment" in which "these pilot strength messages **may be** saved regardless of their strength". Second, for the sake of argument, even if the original specification does disclose the above "one embodiment" in which "these pilot strength messages **may be** saved regardless of their strength", it still does not support the claimed limitations. As admitted by applicant, these pilot strength messages **may be (or may be not)** saved regardless of their strength. Therefore, it is entirely possible that these pilot strength messages are **not** saved regardless of their strength.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wallstedt et al (5,722,073) disclose communication system with MAHO feature.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications; please mark "EXPEDITED
PROCEDURE")

Or:

(703) 305-9508 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen Vo, whose telephone number is (703) 308-6728. The Examiner can normally be reached on Tuesday-Friday from 8:00 AM - 5:30 PM. The examiner can also be reached on alternate Monday.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Nguyen Vo
April 14, 2000



**NGUYEN VO
PRIMARY EXAMINER**